

exist between the design claimed in Eads, or Sargent and the currently claimed design. To briefly summarize the distinguishing features and characteristics of each, Eads describes and claims a rake in which the tines are integrally molded into a rake head. Although molded as one part, the rake of Eads does indeed include a plurality of aligned and extended flexible tines.

Willis, on the other hand, is a design patent for a sand weeding tool, and not a rake at all.

The present invention includes a number of features that are unanticipated in the above mentioned references. These include:

- a leaf rake;
- with a solid tine section;
- made of wood, metal, plastic, or fiberglass;
- having a rake head that is generally triangular in its overall silhouette and has said tine section formed as a downwardly curved radial surface terminating the base end of the triangularly shaped head opposite the handle;
- with a tine section formed a solid surface having a lower grasping edge at the lowermost surface;
- and at least one reinforcing rib formed along the upper surface for providing additional rigidity and spring biasing of the tine section.

These are features undisclosed and unanticipated in the art.

Accordingly, the rejection by the examiner under 35 U.S.C. 102(b) is inappropriate.

The present claims were also rejected by the examiner under 35 U.S.C. 103 based upon the same two references, as well as claims 3-5 being rejected under 35 U.S.C. 103 based upon Sargent in view of Clark. Clark discloses a rake similar to Eads, but incorporating an integrated handle, and Sargeant discloses yet another design patent, although this time for a rake, which includes small tines extending from a solid head. Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection

based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making a leaf rake with solid tine section where the tine section is formed as a

downwardly curved radial surface terminating the base end of the triangularly shaped head opposite the handle and further forms a series of rounded, semicircular, scalloped protrusions linearly aligned along the edge. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Applicant feels that the examiner has cited a number of references variously containing some of the limitation in applicants claim; however, these references and the limitations for which they were cited are combined piecemeal, without any suggestion or motivation for their combination and without regard to the purpose of the applicant's invention. This is similar to the scenario in In re Blammer, Civ. App. No. 93-1108, slip op. At 3-4 (Fed. Cir. Sept. 21, 1993)(unpublished), wherein the examiner in that case rejected an application as obvious in light of twelve references. The Board of Appeals in that matter concluded that the invention would